

## **REMARKS**

### **Status of the claims:**

Claims 1, 4, 9-11, 14, and 16-30 are pending in the application. Claims 1, 11, 14, 17, and 26 have been amended. Support for the amendments can be found in paragraphs [0027] and [0035], Figures 1, 3, and 5 as well as elsewhere in the specification, original claims, and Figures. New claim 30 has been added. Support for new claim 30 can be found in original claim 1 and paragraphs [0027]-[0029], [0031], [0035], [0036], [0041], and [0045] as well as elsewhere in the specification, original claims, and Figures.

Claims 1, 4, 9, 10, 11, 14, 16, 17-23, 26, and 27 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by United States Patent No. 4,825,983 to Nakanishi (hereinafter “Nakanishi”). Claims 1, 4, 9, 11, 14, 16, 17-20, 22, 23, and 26-29 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by United States Patent Publication No. 2004/0113133 to Geissele et al. (hereinafter “Geissele”). Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Geissele.

Applicants respectfully request consideration of the application in view of the foregoing amendments and the following remarks.

### **Rejections under 35 U.S.C. § 102**

#### **Claims 1, 4, 9, 10, 11, 14, 16, 17-23, 26, and 27 and Nakanishi**

The rejection of claims 1, 4, 9, 10, 11, 14, 16, 17-23, 26, and 27 as allegedly being anticipated under 35 U.S.C. § 102(b) by Nakanishi is traversed.

Applicants submit that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner has failed to disclose each and every element set forth in the claims; therefore as a matter of law, the present claims are not anticipated under § 102(b).

Nakanishi describes a device that utilizes a vibration absorbing layer consisting of a gel between the mounting base and inertia weight component.<sup>1</sup> The gel material absorbs external energy.<sup>2</sup>

With respect to claim 1, the Examiner provides that Nakanishi discloses a damping apparatus (as shown in figure 5) comprising a first element 10 adapted to be coupled with a second element 20. The Office Action further provides that the second element comprises a second surface 21, wherein the second surface comprises a receiving surface that is substantially uniform.<sup>3</sup>

However, second surface 21 of Nakanishi is not substantially uniform. The second surface 21 in Figure 5 comprises semi-circular recessed portions 212, thus making the second surface not substantially uniform.<sup>4</sup> Claim 1 of the present listing of claims provides that the second surface comprises a receiving surface that is substantially uniform. Referring to the specification at paragraphs [0026], [0029], and [0038], a surface with semi-circular recessed portions would not be considered substantially uniform. Paragraph [0038] provides that the second surface can be substantially uniform and not structured (structured surfaces be described

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<sup>1</sup> See Nakanishi, col. 1, lines 52-58.

<sup>2</sup> See Nakanishi, col. 1, lines 59-65.

<sup>3</sup> See Office Action, pages 2-3, ¶ 4.

<sup>4</sup> See Nakanishi, col. 5, line 66 to col. 6, line 5 (stating “semi-circular recessed portion 112 and 212, which are opposed each other to form, for example, a number of circular spaces at specified distances on the fitting surfaces 11 and [21]”). Note that col. 6, line 3 contains a typographical error where fitting surface should be labeled 21 and not 12 in order to be consistent with the specification and figures as a whole. See col. 4, lines 16-28 as specific evidence.

in paragraph [0029]). Because Nakanishi does not describe a receiving surface that is substantially uniform, Nakanishi does not describe each and every element of claim 1.

With respect to claims 11 and 17 as amended, Nakanishi fails to describe a machine tool apparatus comprising a second element that comprises a collet. Further, Nakanishi fails to describe a first surface that directly contacts a receiving surface. In the Office Action, the Examiner provides that the second element is defined as ball bearing 50.<sup>5</sup> In Nakanishi, the ball bearing 50 is used to maintain a distance between the first and second component, not to function as a receiving surface for a collet.<sup>6</sup> As amended, claim 11 includes a second element comprising a collet. A collet is a holding device that forms a collar like structure around a first element to be held. As seen in Figures 3 and 5, the collet has a substantially cylindrical shape with a conical receptacle defined by the second surface.<sup>7</sup> Therefore the Examiner's rejection providing that the ball bearing as the second element is no longer applicable. Further, in Nakanishi, component 20 having a surface 21 does not describe each and every limitation, as a gel vibration absorbing layer prevents the direct contact of surface 11 and surface 21 of Nakanishi.

With respect to claim 26, for similar reasons as provided in connection with claims 11 and 17, Nakanishi fails to describe a damping apparatus comprising a substantially cylindrical first element coupled with a substantially cylindrical second element. The ball bearing 50 is spherical-shaped and used to maintain a distance between the first and second component of Nakanishi. Further, Nakanishi does not describe a structured surface comprising depressions directly contacting a receiving surface as a gel vibration absorbing layer prevents the direct contact of surface 11 and surface 21 of Nakanishi.

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<sup>5</sup> See Office Action, page 3, ¶ 8.

<sup>6</sup> See Nakanishi, col. 10, lines 55-59.

<sup>7</sup> See generally Specification at [0035].

For at least these reasons, Applicants assert that independent claims 1, 11, 17, and 26, as amended, are not anticipated by Nakanishi. Further, as claims 4, 9, 10, 14, 16, 18-23, and 27 depend from and further limit the independent claims or an intervening claim, claims 4, 9, 10, 14, 16, 18-23, and 27 are also not anticipated by Nakanishi. Therefore, Applicants respectfully submit that the present rejection be withdrawn, and claims 1, 4, 9, 10, 11, 14, 16, 17-23, 26, and 27 be indicated as allowable.

Claims 1, 4, 9, 11, 14, 16, 17-20, 22, 23, and 26-29 and Geissele

The rejection of claims 1, 4, 9, 11, 14, 16, 17-20, 22, 23, and 26-29 as allegedly being anticipated under 35 U.S.C. § 102(e) by Geissele is traversed.

The Examiner has failed to disclose each and every element set forth in the claims; therefore as a matter of law, the present claims are not anticipated under § 102(e).

Geissele generally describes abrasion assemblies for supporting railroad ties. Geissele nowhere describes machine tool damping apparatus as provided in amended claim 1. With respect to claims 11 and 17, Geissele does not describe a machine tool apparatus having a second element comprising a collet. With respect to claim 26, Geissele does not describe a machine tool apparatus having a substantially cylindrical first element or a substantially cylindrical second element. For at least these reasons, Geissele does not anticipate claims 1, 11, 17, and 26. Further as claims 4, 9, 14, 16, 18-20, 22, 23, and 27-29 depend from and further limit the independent claims or an intervening claim, claims 4, 9, 14, 16, 18-20, 22, 23, and 27-29 are also not anticipated by Geissele. Therefore, Applicants respectfully submit that the present rejection be withdrawn, and claims 1, 4, 9, 11, 14, 16, 17-20, 22, 23, and 26-29 be indicated as allowable.

## **Rejections under 35 U.S.C. § 103**

### **Claims 24 and 25 and Geissele**

The rejection of claims 24 and 25 as allegedly being unpatentable under 35 U.S.C. § 103(a) over Geissele is traversed.

Applicants respectfully submit that a proper *prima facie* case of obviousness has not been made. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

For similar reasons as described above, Geissele does not describe, teach, or suggest a machine tool apparatus having a second element comprising a collet. Further, one of ordinary skill in the art of machine tool apparatuses would not use the teachings of a railroad tie assembly to arrive at the present invention. Applicants request that all the rejections be withdrawn as the Geissele does not disclose each and every element of the present claims. Applicants believe that the present claims are in allowable form, and Applicants request a notice of allowance be immediately entered.

## **Dependent Claims**

In responding to the claim rejections above, Applicants submit that the dependent claims are patentable based on their dependency from independent claims, which Applicants has shown to be patentable. Thus, in many instances, Applicants have not provided separate remarks specifically directed to the Examiner's grounds for rejecting the dependent claims. Applicants' failure to comment on or otherwise traverse the Examiner's rejection of the dependent claims should not be viewed as agreement, on the part of the Applicants, with the Examiner's grounds for rejection.

**New Claims 30**

New claims 30 has been entered into the present application. Support for the new claim can be found generally at original claim 1 and paragraphs [0027]-[0029], [0031], [0035], [0036], [0041], and [0045] in the specification as well as elsewhere in the specification, original claims, and figures. Applicants respectfully submit that the cited prior art does not render new claim 30 anticipated or obvious. Accordingly, Applicants respectfully request that claim 30 also be allowed.

## **CONCLUSION**

Each of the claims remaining in the application is in condition for immediate allowance.

A passage of the instant invention to allowance is earnestly solicited.

Applicants believe that no additional fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone Dean Powell at (336) 607-7347 or Ben Schroeder at (336) 607-7486 (Registration No. 50,990) to discuss any issues.

Respectfully submitted,

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